

REMARKS

By this Amendment, Applicants cancel claims 1, 6, and 11, without prejudice or disclaimer of the subject matter thereof, and amend claims 2-5, 7, 8, 10, and 12-16 to more appropriately define the present invention. Claims 2-5, 7-10, and 12-17 remain pending.

In the Office Action dated August 14, 2003, the Examiner rejected claims 1-3, 5-9, 11-13, and 15-17 under 35 U.S.C § 102(e) as being anticipated by U.S. Patent No. 6,430,289 to *Liffick*; and rejected claims 4, 10, and 14 under 35 U.S.C § 103(a) as being unpatentable over *Liffick* in view of U.S. Patent No. 6,477,374 to *Shaffer et al.* ("*Shaffer*"). Applicants submit that the rejections are improper and should be withdrawn for the reasons discussed below.

Rejection of claims 1-3, 5-9, 11-13, and 15-17 under 35 U.S.C § 102(e)

The rejection of claims 1, 6, and 11 is rendered moot by the cancellation of these claims. Dependent claims 2, 3, 7-9, 12, and 13 are allowable based on their respective dependence from independent claims 4, 10, and 14, each of which is allowable for the reasons discussed in the next section.

With regard to claims 5 and 15-17, Applicants traverse the rejection of these claims as being anticipated by *Liffick*.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the...claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69.

Liffick describes a system for establishing a telephone communication link between parties when the parties are available to communicate (col. 1, lines 44-47). In *Liffick*'s system, a calling party places a call from an originating telephone (col. 12, lines 11-15; FIG. 8, step 200). A central office switch then receives the call data from the originating telephone (FIG. 7, step 202). Subsequently, *Liffick*'s system performs a series of determinations and processes in accordance with user-specified lists and processing criteria (col. 12, line 49 – col. 13, line 57; FIG. 8, steps 206, 210, 212, 214, 216, 218, 220, 222, and 224).

Liffick also describes a process in which "the caller indicates a desire to establish a telephone communication link with the callee" (col. 16, lines 23-25; FIG. 10). According to *Liffick*, the caller indicates such a desire by placing the callee telephone number on a call list. (col. 16, lines 27-34).

In contrast, independent claim 5 recites a combination of steps, including:

requesting authorization from the user to initiate the call, based on a current time and...[an] event time; and

initiating the call to the at least one party on behalf of the user, based on an affirmative response to the authorization request from the user.

① *Liffick* fails to teach or suggest at least the above claimed subject matter. *Liffick*'s system does not request authorization from a user to initiate a call and does not initiate a call to a party on behalf of the user based on an affirmative response to the request. Receiving a call from a calling party and then executing decisions and processes in accordance with user-specified lists and processing criteria, as described by *Liffick*, is not consistent with requesting authorization from a user to initiate a call and then initiating a call on behalf of the user based on an affirmative response to the request, as recited in claim 5. Further, allowing a caller to indicate "a desire to establish a telephone communication link with the callee," as described by *Liffick*, is not

consistent with at least the above-noted elements of claim 5. Thus, *Liffick* fails to teach or suggest each and every element recited in claim 5.

Similar to claim 5, independent claim 16 recites a combination of steps, including:

requesting authorization to initiate the call from the caller, based on a current time and the event time; and

initiating the call to the at least one party on behalf of the caller, based on an affirmative response to the authorization request from the caller.

For at least the reasons presented above in connection with claim 5, claim 16 is not anticipated by *Liffick*.

Independent claim 15 recites a combination of steps including:

determining that a current time is within...[a] time period for initiating the call;

notifying the user that the call is about to take place...[and]

receiving confirmation from the user to initiate the call to the one or more parties on behalf of the user.

② *Liffick* fails to teach or suggest at least the above-noted claimed subject matter. Contrary to the Examiner's position (Office Action, page 7), specifying periods for accepting incoming calls and blocking calls during certain times, as mentioned by *Liffick*, is not consistent with determining that a current time is within a time period for initiating a call, as claimed.

Further, as the Examiner concedes (in applying *Liffick* in a § 103 rejection, Office Action, page 7), *Liffick* fails to teach notifying the user that a call is about to take place, as claimed.

Moreover, *Liffick* fails to teach or suggest at least receiving confirmation from the user to place the call to the one or more parties on behalf of the user. Contrary to the Examiner's position (Office Action, page 7), determining whether caller identification is in an "allow list," as

described by *Liffick*, is not consistent with receiving a confirmation from a user to place a call to a party on behalf of the user, as claimed.

3 Thus, *Liffick* fails to teach or suggest each and every element recited in claim 15.

2 Independent claim 17 recites a combination of steps including:

receiving event information for the service subscriber via a data network, including a selection of one of the parties and a call time; and

based on the call time of the event information, selecting from the database a telephone number for the service subscriber and a telephone for selected party, and initiating the call based on the call time using the selected telephone numbers.

2 Despite the Examiner's allegations, *Liffick* fails to teach at least the above-noted claimed subject matter. The relied-upon portions of *Liffick* (col. 11, lines 29-37, 41-62; col. 12, lines 11-20, 32-65) do not anticipate the above-mentioned features of claim 17. Receiving a call from a calling party and then executing decisions and processes in accordance with user-specified lists and processing criteria, as described by *Liffick*, is not consistent with receiving a selection of a party and a call time and then selecting from the database a telephone number for the service subscriber and a telephone for selected party and initiating the call based on the call time using the selected telephone numbers, as recited in claim 17. Moreover, specifying periods for accepting incoming calls and blocking calls during certain times, as mentioned by *Liffick*, is not consistent with the above-noted features of claim 17.

21 Thus, *Liffick* fails to teach or suggest each and every element recited in claim 17.

As set forth above, anticipation under 35 U.S.C. § 102(b) requires that each and every claim element be disclosed in as complete detail as is in the claim by the applied reference.

Liffick does not teach each and every feature of independent claims 5 and 15-17 and therefore, as

a matter of law, cannot anticipate these claims. Thus, the rejection of independent claims 5 and 15-17 under 35 U.S.C. §102(e) as anticipated by *Liffick* should be withdrawn.

Accordingly, for reasons presented above with respect to claims 5 and 15-17, and for reasons discussed in the next section with respect to independent claims 4, 10, and 14 from which claims 2-3, 7-9, and 12-13 depend respectively, Applicants request withdrawal of the rejection under 35 U.S.C. § 102(e) and the timely allowance of claims 2, 3, 5, 7-9, 12, 13, and 15-17.

Rejection of claims 4, 10, and 14 under 35 U.S.C § 103(a)

Applicants traverse the rejection of claims 4, 10, and 14 under 35 U.S.C § 103(a), as a *prima facie* case of obviousness has not been established with respect to these claims. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

Independent claim 4 recites a combination of elements including:

determining that a current time is within the time period for initiating the call [included in the event data];

notifying the user that the call is about to take place...[and]

receiving confirmation from the user to initiate the call to the one or more parties on behalf of the user.

As noted above, the Examiner concedes that *Liffick* fails to teach notifying the user that a call is about to take place, as claimed. In rejecting claim 4, the Examiner relies on *Shaffer* in an attempt to cure this deficiency of *Liffick*. The Examiner alleges that *Shaffer* discloses "reminding the called party that the call is about to take place" (Office Action, page 7). According to the Examiner, it would have been obvious to a skilled artisan

to modify *Liffick* to allow notifying the user that the call is about to take place...in order to provide [a] reminder of call connection between the caller and the called party. (Office Action, page 7).

Despite the Examiner's allegations, *Shaffer* does not cure the above conceded-to deficiency of *Liffick*. *Shaffer* describes a system for routing calls "based on a pre-programmed calendar of time-date associations" (Abstract). As the Examiner notes, *Shaffer* mentions that a window 6270 may pop up at a called party's computer (col. 17, lines 11-20). The window identifies the calling party, and the called party is given the option of dismissing the reminder, postponing the call, or call the called party back. *Shaffer* also mentions a call back reminder window 1270, which is presented to the caller after the caller initially attempts to call a party without success (col. 16, lines 15-45).

Shaffer does not teach or suggest at least notifying the user that a call is about to take place, as recited in claim 4. Presenting a pop up window identifying a calling party, as mentioned by *Shaffer*, is not consistent with notifying the user that a call is about to take place, as recited in claim 4. Further, presenting a call back reminder window to a caller after the caller initially attempts to call a party without success, as mentioned by *Shaffer*, is not consistent with notifying the user that a call is about to take place, as recited in claim 4. Thus, neither *Liffick* nor *Shaffer*, nor any combination thereof, teaches or suggests notifying the user that a call is about to take place, as recited in claim 4.

Moreover, neither *Liffick* nor *Shaffer*, nor any combination thereof, teaches or suggests at least the following elements recited in claim 4:

determining that a current time is within the time period for initiating the call...[and]

receiving confirmation from the user to place the call to the one or more parties on behalf of the user.

As explained above in connection with claim 15, *Liffick* does not teach or suggest at least the above-noted elements of claim 4. And Applicants submit that *Shaffer* fails to cure *Liffick*'s deficiencies.

Thus, neither *Liffick* nor *Shaffer*, nor any combination thereof, teaches or suggests all of the features recited in claim 4. Accordingly, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking. See M.P.E.P. §§ 2142, 2143, and 2143.03. For at least this reason, a *prima facie* case of obviousness has not been established by the supposed combination of *Liffick* and *Shaffer*.

Moreover, even if *Shaffer* could cure *Liffick*'s deficiencies—Applicants disputing that notion—a *prima facie* case of obviousness has not been established with respect to claim 4. Applicants remind the Examiner that determinations of *prima facie* obviousness must be supported by a finding of “substantial evidence.” See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless “substantial evidence” found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

In this case, there is no “substantial evidence” in the record to support the proposed modification of *Liffick* in view of *Shaffer*, and the requisite “clear and particular” motivation required to support a *prima facie* case of obviousness is lacking. The Examiner points to no evidence supporting the assertion that a skilled artisan having *Liffick* before him would have

been motivated to modify the reference in view of *Shaffer* in a manner resulting in Applicants' claimed invention. The Examiner merely provides a general description of how *Shaffer* allegedly teaches certain features and provides only conclusory statements, lacking evidentiary basis, to support a motive for modifying *Liffick* in a manner resulting in Applicants' claimed combination. For example, the Examiner alleges that a skilled artisan would have combined the references in order to "provide [a] reminder of call connection between the caller and the called party" (Office Action, page 7). This statement is not supported by "substantial evidence" on the record, as the Examiner points to evidence in *Liffick* or *Shaffer* mentioning such a "reminder of call connection between the caller and the called party." The relied-upon portions of *Shaffer* merely mention presenting a pop up window identifying a calling party. Further, the Examiner fails to provide any evidence or reasoning to show that a skilled artisan having *Liffick* before him would have been concerned with providing reminders of call connections between a caller and called parties. The Examiner also fails to show how the proposed modification to *Liffick* would in fact yield a reminder of a call connection in *Liffick*'s system.

Applicants submit that no motivation exists, aside from an attempt to meet the terms of Applicants' claims, to combine the pop-up windows of *Shaffer* with *Liffick*'s system. Further, Applicants point out that the mere fact that references can be combined is insufficient to establish a *prima facie* case of obviousness (See MPEP § 2143.01).

Each of claims 10 and 14 recites subject matter paralleling the subject matter recited in allowable claim 4. In particular, claim 10 recites, *inter alia*:

a transmitter for connecting the caller via the telephone network to the one or more parties based on the event data, wherein the transmitter determines that a current time is within the time period for connecting, notifies the caller that a connection is about to take place, and receives confirmation from the caller to initiate the connection to the one or more parties.

And claim 14 recites, *inter alia*:

means for determining that a current time is within the time period for connecting;

means for notifying the user that a connection is about to take place;

means for receiving confirmation from the user to initiate the connection to the one or more parties on behalf of the user

For at least the reasons presented above in connection with claim 4, a *prima facie* case of obviousness has not been established with respect to claims 10 and 14.

Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claims 4, 10, and 14.

Conclusion:

In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified above, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2339.

Respectfully submitted,

Dated: November 18, 2003

By: 

Joel Wall
Registration No. 25,648